

REMARKS

Status of the Claims

The final Office Action mailed November 24, 2009 noted that claims 13-18 and 32 were pending, rejected claims 13-18 and that claim 32 was subject to a restriction requirement. Claims 13, 15 and 18 are amended. No claims are cancelled. No new claims are added. No new matter is believed to be presented.

A Request for Continued Examination is submitted herewith. It is respectfully submitted that claims 13-18 and 32 are pending and under consideration.

Election-Restriction Requirement

The Office Action, on page 2, constructively elected claims 13-18 for prosecution on the merits and withdrew claim 32 from consideration as being directed to a non-elected invention. Particularly, the Office Action asserted "claims 13-18 are directed towards system for distributing advertising selected by a user" and "newly added claim 32 recites a separate and distinct invention which identifies a method for tailoring an advertisement based on user interest." However, it is submitted that the assertion by the Office Action is incorrect.

According to MPEP § 821.03, if, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144. However, in this case, claim 32 is neither independent nor distinct from the previously presented claims. According to MPEP § 802.01, the term "independent" means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect. For example, a process and an apparatus incapable of being used in practicing the process are independent inventions. See also MPEP § 806.06 and § 808.01.

As an example, claim 15 recites "the detector detects a position of the symbolic image on the advertisement requesting domain and transmits the position data to the advertisement distribution reservation requesting unit, the advertisement distribution reservation requesting unit transmits the distribution reservation requesting data to the advertisement distributor including the position of the symbolic image on the advertisement requesting domain and said information display displays the advertisement information adjusted depending on the position of symbolic

image in the advertisement requesting domain from the information distributor.” Claim 16 recites “the advertisement distribution reservation requesting unit detects whether other symbolic images already exist in the advertisement requesting domain and also transmits, when the other symbolic images are detected, information relating to the other symbolic images to the advertisement distributor.”

Claim 32 recites “the advertisement information tailored based on user interest dependent upon a position of the symbolic image in the advertisement space and other symbolic images and their corresponding positions in the advertisement space.”

Thus, it is clear that dependent claim 15 is related to transmitting distribution requesting data to the advertisement distributor including **the position of the symbolic image on the advertisement requesting domain and said information display displays the advertisement information adjusted depending on the position of symbolic image in the advertisement requesting domain from the information distributor** and claim 16 detects **other symbolic images** and transmits information relating to the symbolic images to the advertisement distributor. Similar to claims 15 and 16, claim 32 recites “the advertisement information tailored based on user interest **dependent upon a position of the symbolic image in the advertisement space and other symbolic images and their corresponding positions in the advertisement space.**”

According to MPEP § 802.01, related inventions are distinct if the inventions *as claimed* are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (though they may each be unpatentable over the prior art). See MPEP § 806.05(c) (combination and subcombination) and § 806.05(j) (related products or related processes) for examples of when a two-way test is required for distinctness.

As noted above, claim 32 recites “the advertisement information tailored based on user interest **dependent upon a position of the symbolic image in the advertisement space and other symbolic images and their corresponding positions in the advertisement space,**” claim features which are both are connected in design, operation, and effect to claim features in dependent claims 15 and 16 because claim 32, like claims 15 and 16, is related to providing advertisement information based on a position of the symbolic image and other symbolic images which are chosen by a user. In other words, claim 32 recites claim features based on claims 15 and 16 using a somewhat different wording. Claim 15 notes that advertisement information is

based on a position of the symbolic image and claim 16 notes that advertisement information is based on other symbolic images. Thus, claim 32 is not distinct from claims 13-18.

In conclusion, it is respectfully submitted that claim 32 was improperly withdrawn from consideration. Withdrawal of the restriction of claim 32 is requested.

Rejection under 35 U.S.C. § 112

The Office Action, on page 3, rejected claims 13-18 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. This rejection is respectfully traversed below.

Claim 13, for example, is amended to recite:

a display displaying, on the user terminals, an advertisement requesting domain including **a section of a user interface** for accepting an advertisement distribution reservation;

a detector executed by the processor and for detecting that a user has selected at least one symbolic image corresponding to an information provider and has moved the symbolic image by **clicking, dragging and dropping the symbolic image** to the advertisement requesting domain.

Claim 13 is amended to clarify that "an advertisement requesting domain" is "a section of a user interface for accepting an advertisement distribution reservation." Furthermore, claim 13 is amended to clarify that detecting selection of a symbolic image includes "clicking, dragging and dropping the symbolic image to the advertisement requesting domain." Claims 14-18 depend upon claim 13. In light of the amendment to better clarify distinctive features of claim 13, it is respectfully submitted that the rejection is overcome.

Rejection under 35 U.S.C. § 102

The Office Action, on page 4, rejected claims 13 and 17-18 under 35 U.S.C. § 102(b) as being anticipated by Goldhaber.

It is respectfully submitted that nothing cited or found in Goldhaber discusses "a display displaying, on the user terminals, an advertisement requesting domain including a section of a user interface for accepting an advertisement distribution reservation" and "a detector executed by the processor and for detecting that a user has selected at least one symbolic image corresponding to an information provider and has moved the symbolic image by clicking, dragging and dropping the symbolic image to the advertisement requesting domain" recited, for example in claim 13. Goldhaber merely discusses in column 10, lines 38-59, that a consumer

uses her computer 104 to read information 56 (and, in some embodiments, to interact with the information thereby evidencing that she has paid attention to it). The consumer is then paid by digital cash or credit to a consumer's account. Goldhaber is entirely silent regarding "detecting that a user has selected...and moved the symbolic image by clicking, dragging and dropping the symbolic image to the advertisement requesting domain" which is "a section of a user interface for accepting an advertisement distribution reservation." This dragging and dropping of a symbolic image results in "displaying advertisement information distributed from the advertisement distributor to the user terminal corresponding to the user."

Dependent claims 17 and 18 depend upon claim 13 and thus patentably distinguish over Goldhaber. The dependent claims also recite additional features not taught or suggested by the cited references. For example, claim 18 recites "acquires positional information relating to the symbolic image as the object of the advertisement information existing in the advertisement requesting domain and also transmits the symbolic image included in the advertisement information and the obtained positional information to the advertisement distribution reservation requesting unit and the advertisement distribution reservation requesting unit also includes a generating unit generating the distribution reservation requesting data based on the symbolic image included in the advertisement information transmitted with the detector and the obtained positional information." Goldhaber is entirely silent regarding positional information. In other words, positional information related to the symbolic image is included to generate advertisement information. As an example, this allows the advertisement information to be better geared to a user based on the positional information. Positional information is shown as "near," "middle" and "far" for icon id icon-v101-349-v1 in Figure 12. It is submitted that the dependent claims are independently patentable over the cited references.

Rejection under 35 U.S.C. § 103

The Office Action, on page 5, rejected claims 14-16 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Goldhaber and Ludolph. This rejection is respectfully traversed below.

In the outstanding Office Action, the complete rejection intended to be set forth in the Office Action is unclear to Applicants, and Applicants are at a disadvantage for effectively responding to the outstanding rejection. Further, as set forth below, the rejection under 35 U.S.C. § 103(a) fails to set forth a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Unfortunately, the Office Action does not specifically reject claims 14, 15 and 18 in both the previous non-final action and the current action and thus has repeatedly failed to provide a *prima facie* case of obviousness. As noted in MPEP 707.07(d): "[a] plurality of claims should

never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group." In this case, the Office Action has grouped together claims 14-15 and 18 and has not made it clear what cited portions of the references Goldhaber and Ludolph are used to reject the claims. MPEP 2141 specifically notes "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 **should be made explicit.**" (Emphasis Supplied) Unfortunately, because this rejection fails to clearly articulate the reason why claims 14 and 15 are rejected and groups claims 14, 15 and 18 together, Applicant cannot properly respond without guessing the reasons why claims 14, 15 and 18 are rejected, and this burden has been improperly shifted onto the Applicant.

As best understood and to advance prosecution, Applicant provides reasons for why Goldhaber and Ludolph, taken alone and in combination, do not discuss all features recited in claims 14-16 and 18.

The dependent claims 14-16 and 18 depend from the above-discussed independent claims and are patentable over the cited references for the reasons discussed above. The dependent claims also recite additional features not taught or suggested by the cited references. For example, claim 14 recites "the advertisement provider display includes a position changing unit changing a display position of a symbolic image in response to a user manipulation and a management unit managing the display position of the symbolic image for each user, the advertisement distribution reservation requesting unit transmits the distribution reservation requesting data to the advertisement distributor, including the display position of the symbolic image as a selection object, and **the information display receives and displays the advertisement information adjusted depending on the display position of the symbolic image transmitted from the advertisement distributor.**" Nothing cited or found in Goldhaber and Ludolph discusses "displays the advertisement information **adjusted depending on the display position of the symbolic image transmitted from the advertisement distributor.**" In other words, different advertisement information is displayed depending on a position in the advertisement requesting domain. Goldhaber and Ludolph do not discuss "advertisement information adjusted depending on the display position." Ludolph merely discusses dragging icons onto a Desk Drawer. Goldhaber merely discusses displaying advertisement information. The references are silent regarding the adjustment in advertisement information which is dependent upon on the display position of the symbolic image and thus nothing cited or found teaches "advertisement information adjusted depending on the display position."

The Office Action does not specifically reject claim 14 and nothing cited or found in the references discusses all features of claim 14. Thus, it is submitted that the dependent claims are independently patentable over the cited references.

Claim 32

It is respectfully submitted that claim 32, which was improperly withdrawn from consideration, patentably distinguishes over Goldhaber and Ludolph, taken alone and in combination, for reasons similar to those discussed above because nothing cited or found discusses "displaying advertisement information in the virtual social space of the interface corresponding to the symbolic image if the symbolic image is located in the advertisement space of the interface, the advertisement information tailored based on user interest dependent upon a position of the symbolic image in the advertisement space and other symbolic images and their corresponding positions in the advertisement space." In particular, Goldhaber and Ludolph do not discuss "the advertisement information tailored based on user interest dependent **upon a position of the symbolic image in the advertisement space and other symbolic images and their corresponding positions in the advertisement space.**" As a non-limiting example, if a user has three different images representing three different products or services in the virtual social space arranged as left, center and right, and is most interested in the product represented by the image on the left, by placing this product on the left and the two others in the center and right, advertisement information could be tailored to compare the product he is interested in with the two other products, or a larger amount of the advertising information could be provided for the product on the left while less information is provided for the product in the center and even less for the product on the right.

Summary

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 2-24-10

By: 
John R. Bednarz
Registration No. 62,168

1201 New York Avenue, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501